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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,555	09/21/2006	Peter Niebling	INA-49	7861
20311 7590 04/07/2009 LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016				
EXAMINER HANNON, THOMAS R				
ART UNIT		PAPER NUMBER		
3656				
MAIL DATE		DELIVERY MODE		
04/07/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/596,555

**Applicant(s)**

NIEBLING ET AL.

**Examiner**

Thomas R. Hannon

**Art Unit**

3656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5506)  
Paper No(s)/Mail Date 1/23/09

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the subject matter of claim 9 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show the groove 2k as annular as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Different embodiments must not be shown in the same figure.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation of "a raceway for the rolling bodies is formed at least partially on scalloped section" in each of claims 1, 7 and 15 is not understood. What is this "scalloped section"? In what way is the section scalloped?

Additionally, with respect to claim 7, the limitation of "the fastening element is prestressed axially fixedly against the flange with a head the fastening element being fixed to the wheel carrier" is not understood.

Claim 13 lacks a proper antecedent for "the non-scalloped sections".

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 13, 14, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Griseri et al. US 2002/0015545. Griseri discloses a wheel bearing (16) in a wheel carrier (10), the wheel bearing (16) having at least one outer ring (18), having at least one row of rolling bodies (19a, 19b), the wheel bearing (16) being supported in the wheel carrier (10) at least on a cylindrical section (24) of the outer ring (18) at least radially with respect to the rotational axis, and the outer ring (18) having a flange (25a, 37) which points radially away from the rotational axis, characterized in that a raceway for the rolling bodies is formed at least partially on a section

(18, to the extent understood, the raceway surface section is scalloped), and in that the flange (25a, 37) is formed axially on the end side of the outer ring (18), the flange being fastened axially to the wheel carrier (10). The flange is fastened by means of the opposite flange 26a. With respect to claim 2, these claim features are inherent in the interference fit set forth in Griseri et al. With respect to claims 3, 4, and 6, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). With respect to claim 5, the wheel bearing of Griseri includes at least one inner ring (17) having a raceway. With respect to claim 13, the flange bears against the wheel carrier, which, to the extent understood is in a non-scalloped section. With respect to claim 14, a radial shoulder (at 23) is formed in one piece with the outer ring between the rows. With respect to claim 16, Griseri further discloses in that the wheel carrier (10) engages around at least the raceway of the outer ring (18), a hub (cylindrical portion of 10) being supported in the outer ring (18) via the rolling bodies (19a, 19b) on the raceway in such a way that it can rotate about the rotational axis, and a wheel flange (11) leading radially from the hub.

Claims 7-12, and 15 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Applicant's arguments filed January 23, 2009 have been fully considered but they are not persuasive.

With respect to the drawing objection for failing to show the subject matter of claim 9, Applicant states the subject matter of claim 9 is shown in Figure 2. However, Figure 2 does not show the fastening element being a bolt with a head bearing axially against the flange by engaging through a recess of the flange, wherein the recesses are open radially to the outside, all as required by claim 9. Additionally, with respect to the drawing objection for failing to show the groove 2k as annular as described in the specification, Applicant states that Figure 2 shows annular groove 2k. However, Figure 1 also includes reference number 2k for indicating the annular groove, yet the top portion of the figure showing the outer race does not show the groove 2k, which would indicate that the groove is not annular. Correction of Figure 1 is required to show the groove 2k as annular.

With respect to Griseri, Applicant states "Griseri does not disclose scalloped sections on the flange attached to the outer ring." This argument is not understood. As amended, each of the independent claims refers to "a raceway for the rolling bodies is formed at least partially on scalloped section". In addition to being grammatically awkward, this limitation is unclear, confusing, and is not understood. Applicant has not indicated any portion of the specification which supports the added limitation of "scalloped portion", nor is it adequately set forth in the claim to render the scope of the claim. Applicant's arguments appear to contradict the language of the claim with respect to the claim language. Applicant refers to "scalloped section on the flange attached to the outer ring" yet this language is not found in the claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas R. Hannon whose telephone number is (571) 272-7104. The examiner can normally be reached on Monday-Thursday (8:30-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard WL Ridley can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas R. Hannon/  
Primary Examiner, Art Unit 3656